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No. 99-150

IN THE

Supreme Court of the United States

Wal-Mart Stores, Inc.

Petitioner,

—v.—

Samara Brothers, Inc.

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Second Circuit

BRIEF OF AMICUS CURIAE THE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF NEITHER PARTY

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INTRODUCTION

The International Trademark Association ("INTA"),[1] having obtained written consent of the parties pursuant to Rule 37.3 of the Rules of this Court,[2] submits this brief as

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[1] This brief was not authored, in whole or in part, by counsel to a party and no monetary contribution to the preparation or submission of this brief was made by any person or entity other than the amicus curiae or its counsel. Neither petitioner nor respondent is a member of amicus curiae. The law firm of petitioner's counsel is an associate member, but has not participated in the decision to submit this brief, in its preparation, or in its submission.

[2] The consents have been filed with the Clerk with this brief.

amicus curiae. INTA believes that the legal premise underlying the Court of Appeals' opinion—that nonfunctional aspects of a product's configuration or ornamentation may qualify for protection as inherently distinctive trade dress—is correct. Nevertheless, INTA questions whether the Court of Appeals applied the appropriate standard in holding that the trade dress at issue is inherently distinctive.

Beyond the Court of Appeals' general description, INTA is not familiar with the details of plaintiff's line of children's clothing, or with the evidence on which the jury relied. It thus does not take a position as to whether the Court of Appeals' decision should be affirmed. Instead, INTA's purpose in filing this amicus brief is: (a) to suggest that a different standard should be applied to product, as opposed to packaging, designs; and (b) to urge that the test formulated in the *Seabrook* case,[3] not the "*Abercrombie* spectrum,"[4] is the appropriate standard for assessing the inherent distinctiveness of a product's appearance.

STATEMENT OF INTEREST OF THE AMICUS CURIAE

INTA is a not-for-profit corporation whose more than 3700 members have a special interest in trademarks. They include trademark owners, law firms, advertising agencies, package design firms and professional associations from the United States and 119 other countries. All share the goals of emphasizing the importance of trademarks and trademark protection, and of promoting an understanding of the essential role trademarks play in fostering informed decisions by consumers, effective commerce, and fair competition. INTA members frequently are participants in trademark litigation, and therefore are interested in the development of clear and consistent principles of trademark and unfair competition

[3] *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977).

[4] *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

law. INTA has substantial expertise in trademark law and has selectively participated as an amicus curiae in cases involving vital trademark issues.[5]

INTA was founded in 1878 as the United States Trademark Association, in part to encourage the enactment of federal trademark legislation after this country's first trademark act was declared unconstitutional. Since that time, INTA has been instrumental in making recommendations and providing assistance to legislators in connection with each subsequent trademark act, or amendment thereof, including the Trademark Law Revision Act of 1988 ("TLRA"). *See* 134 Cong. Rec. S16974 (daily ed. Oct. 20, 1988) (statement of Sen. DeConcini). One significant revision included in the TLRA was the amendment of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), to acknowledge the evolution of the section since 1946 "into a Federal law of unfair competition," 135 Cong. Rec. H10422 (daily ed. Oct. 19, 1989) (statement of Rep. Moorhead), protecting, *inter alia*, unregistered trademarks and trade dress. *See* S. Rep. No. 100-515, at 40 (1988).

In addition, the Lanham Act was amended to adopt the view expressed by a majority of federal courts that all of

[5] Cases in which INTA has filed amicus briefs include: *College Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 119 S. Ct. 2219 (1999); *Dickinson v. Zurko*, 119 S. Ct. 1816 (1999); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988); *WarnerVision Entertainment Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996); *Preferred Risk Mut. Ins. Co. v. United States*, 86 F.3d 789 (8th Cir. 1996); *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556 (Fed. Cir. 1994); *Ralston Purina Co. v. On-Cor Frozen Foods, Inc.*, 746 F.2d 801 (Fed. Cir. 1984); *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316 (9th Cir. 1982); *In re Borden, Inc.*, 92 F.T.C. 669 (1978), *aff'd sub nom Borden, Inc. v. Fed. Trade Comm'n*, 674 F.2d 498 (6th Cir. 1982), *vacated and remanded*, 461 U.S. 940 (1983); *Redd v. Shell Oil Co.*, 524 F.2d 1054 (10th Cir. 1975); *Century 21 Real Estate Corp. v. Nevada Real Estate Advisory Comm'n*, 448 F. Supp. 1237 (D. Nev. 1978), *aff'd*, 440 U.S. 941 (1979).

the remedies available for infringement of registered marks are also available for infringement of unregistered marks and trade dress. TLRA, §§ 127-30, 102 Stat. at 3943-45; 133 Cong. Rec. S16347 (daily ed. Nov. 19, 1987) (statement of Sen. DeConcini). Where appropriate, however, INTA has also encouraged the enactment of statutory revisions aimed at restricting overreaching trade dress claims. *See* Trademark Amendments Act of 1999, § 5, Pub. L. No. 106-43, 113 Stat. 218, 220 (1999).

INTA has a particular interest in this case for three reasons. First, it wishes to ensure that section 43(a) will continue to be applied in a manner consistent with traditional principles of trademark law. This section is the means by which the vast majority of trade dress disputes are litigated in the federal courts, and its uniform evolution was one of the congressional goals of enacting the TLRA.

Second, in cases involving claims to product configurations and ornamentation (hereinafter "product design" or "product appearance"), there is a split among the approaches used by the Courts of Appeals for implementing the holding in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992). Some Circuits hold that product design can rarely, if ever, serve as an inherently distinctive indicator of origin,[6] and other Circuits appear to hold that virtually any product design that is nonfunctional merits trade dress protection.[7]

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[6] The Second Circuit "appears to be moving toward a rule that packaging is usually indicative of a product's source, while the design ... of the product is usually not so." *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 379 (2d Cir. 1997); *see also Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431 (3d Cir. 1994). Other than the decision under review, no court applying recent Second and Third Circuit precedent "has found a product design inherently distinctive." Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C.L. REV. 471, 557 (1997).

[7] *See Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 785-87 (8th Cir. 1995) ("[T]he question ... is whether, and how much, the trade dress is dictated by the nature of the product, not whether consumers remember

Third, the question for which certiorari was granted provides the Court with an opportunity to clarify principles underlying both the trade dress protection to be afforded companies for the substantial investments often made in nonfunctional product designs, and the rights of competitors fairly to enter a market by adopting popular design elements in the public domain.

SUMMARY OF THE ARGUMENT

Trade dress, as is the case with any word, symbol, or other device, is eligible for protection if it distinguishes goods or services of one competitor from those offered by others. The appropriate inquiry in every instance is whether the trade dress is nonfunctional and is perceived as identifying and distinguishing goods and services, enabling purchasers to associate them with a particular, albeit often unknown, source. If the answer to that inquiry is "yes," the trade dress is protectable. Although more cases have addressed the concept of distinctiveness in the context of words than trade dress, this Court has properly recognized that there are varying degrees of distinctiveness that may attach to both.

At one end of the spectrum are words and trade dress that are wholly incapable of possessing distinctiveness as brand signals because they denote the product itself, and there is no alternative way to produce and sell competitive goods without using the same word or dress that the initial user has tried to appropriate for itself. If such exclusive appropriation would render others unable to communicate or compete, no protection is available.

In the middle are words and trade dress that, at the time of adoption, primarily perform a role directly related to a product, *e.g.*, they describe a characteristic of the product or serve only as ornamentation. Such nondistinctive words

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or are struck by the design, or whether consumers associate the design with its source"); *see also Insty*Bit, Inc. v. Poly-Tech Indus.*, 95 F.3d 663 (8th Cir. 1996), *cert. denied*, 519 U.S. 1151 (1997).

and trade dress can come to serve as indications of origin, but only after they acquire, through use, a "secondary meaning" associating them with a single source. Prior to the acquisition of secondary meaning, they are not entitled to protection because they do not perform a trademark function.

At the other end of the spectrum are words and trade dress that are deemed "inherently distinctive" because their source-identifying function is readily apparent from the outset. As a result, they are entitled to protection upon adoption. When dealing with such trademarks or trade dress, it is superfluous to require proof that these symbols have acquired a "secondary meaning," because their primary meaning *is* to communicate a source-identifying message.

The Court of Appeals correctly accepted as an underlying principle the proposition that it is possible, in a proper case, for nonfunctional aspects of a product's design to serve as inherently distinctive trade dress without proof of secondary meaning. It appears, however, that the Court of Appeals may have characterized Samara's line of clothing as inherently distinctive without considering the differing perceptions consumers attach to a product's appearance, as opposed to packages and labels.

In *Two Pesos*, for example, this Court dealt with packaging trade dress. *See* 505 U.S. at 786-87 (Thomas, J., concurring); *Duraco Prods., Inc. v. Joy Plastics Enters.*, 40 F.3d 1431, 1445 (3d Cir. 1994). The restaurant "look" at issue was not the product sold but, like the "Golden Arches" of McDonald's, was a device to identify origin, and consumers have become highly sensitized in appreciating the brand significance of such symbols.[8] In thus discussing whether the "look" in *Two Pesos* was generic, descriptive or inher-

[8] *See, e.g., Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995) ("The imaginary word 'Suntost' ... on a jar of orange jam immediately would signal a brand...."); *see also Duraco Prods.*, 40 F.3d at 1448 (consumers have "common abundant experience [in distinguishing] similar goods [based on] differing packaging").

ently distinctive, the Court referred to what is frequently denominated the "*Abercrombie* spectrum," which has been utilized in assessing the likely impact of words and packages on consumers. 505 U.S. at 768 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)).

In this case, the Court is confronted with product trade dress—the appearance or design of a product—that consumers are less likely to regard as a brand signal, and as to which, INTA submits, the *Abercrombie* test is inappropriate. The Court of Appeals, moreover, may have overly emphasized Samara's intent to foster brand loyalty with its designs, and insufficiently explored whether that intent was inherently communicated to the marketplace. Although intent may be one relevant factor, assessments of inherent distinctiveness involve predictions of how *consumers* will react to a design, *e.g.*, as an indication of source or merely as a desirable feature of the goods.

In evaluating likely consumer reactions to product designs, it is submitted that the inquiry should be visually articulated: (1) whether the design is a common, or basic shape; (2) whether it is unique or unusual in the field; (3) whether it is a mere refinement of a commonly-adopted look in the field; and (4) whether it is capable of creating an impression distinct from the product itself. The degree of any singularity of a design must be assessed, and the nature of a specific market may bear heavily on whether product appearance functions as a brand.

INTA has not had access to the record, and does not have an opinion on the application of this test to the facts of this case. It files this brief to emphasize the policies and principles that underlie the inquiry, and the importance of balancing the ability of sellers to communicate accurate and useful information about product source to consumers with the need of competitors to have access to product features and other indicia necessary for effective competition.

ARGUMENT

I. Product Design Can Be Protectable Trade Dress.

Under the Lanham Act, a "trademark" may be "any word, name, symbol, or device, or any combination thereof" used by an owner "to identify and distinguish [its] goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127 (1994 & Supp. III 1997). When the mark in question consists of a nonverbal designation of origin, it is often referred to as "trade dress." As this Court has recognized, the distinction between "trademarks" and "trade dress" is often one of semantics. *See Two Pesos*, 505 U.S. at 773 ("[T]he protection of trademarks and trade dress ... serves the same statutory purpose of preventing deception and unfair competition.").

In its most common form, trade dress consists of the packaging and labels for a particular product. *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 831 (11th Cir. 1982) ("[T]he majority of trade dress claims involve a manufacturer's container or packaging ...."). Trade dress can also consist of the appearance of buildings, *Two Pesos*, 505 U.S. 763, a single color, *Qualitex*, 514 U.S. 159, a fragrance, *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990), a sound, *In re General Elec. Broad. Co.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978), or unique sales techniques. *See Original Appalachian Artworks*, 684 F.2d at 831.

It is also obvious that the nonfunctional aspects of a product's appearance can constitute protectable trade dress. *See, e.g., Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260 (Fed. Cir. 1995) (furniture); *Kohler Co. v. Moen Inc.*, 12 F.3d 632 (7th Cir. 1993) (water faucet). In enacting the Trademark Law Revision Act of 1988, Congress sought to codify the judicial extension of trade dress protection to product design under the Lanham Act. *See* S. Rep. 100-515, *supra*, at 44. Indeed, with respect to some products, *e.g.*,

automobiles, a visibly unique design can operate as efficiently as a word mark in distinguishing one source from another. *See, e.g., Chrysler Corp. v. Silva*, 118 F.3d 56, 57 (1st Cir. 1997) ("[T]here is enormous competition that depends upon the body appearance of automobiles.").

To qualify under sections 32 or 43 of the Lanham Act, 15 U.S.C. §§ 1114, 1125, for protection against infringement, a claimant's trade dress must be (1) a distinctive indicator of origin and (2) "nonfunctional," *i.e.*, not essential to the use or purpose of the associated good or service or affecting its cost or quality. Provided that these prerequisites are met, trade dress protection for product design does not create a conflict with federal patent or copyright law. *See, e.g., W.T. Rogers Co. v. Keene*, 778 F.2d 334, 337 n.8 (7th Cir. 1985); *see also Midwest Indus. v. Karavan Trailers, Inc.*, 175 F.3d 1356 (Fed. Cir. 1999). Nevertheless, "[r]igorous application of the requirements of distinctiveness and nonfunctionality is essential in order to avoid undermining the carefully circumscribed statutory regimes ... [of] federal patent and copyright law." Restatement (Third) of Unfair Competition § 16 cmt. b (1995).

II. The Historical Test for Distinctiveness of Word Marks is Uniquely Suited for Those Marks.

A summary of the law as to more traditional trademark symbols may assist in devising the test that should be applied to less traditional product designs. Where conventional words are concerned, courts have long had the benefit of a cohesive framework for measuring distinctiveness. Under it, words used to communicate information with respect to products fall broadly into five categories: (i) generic; (ii) descriptive, (iii) suggestive; (iv) arbitrary; and (v) fanciful. *See Abercrombie & Fitch*, 537 F.2d at 9.

Words with a primarily generic meaning are essential to effective communication, and unfair competition law does not permit their monopolization by individual competitors.

See Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921). Because generic terms delineate a category of goods, they do not serve to differentiate and identify the particular goods of one producer; they do not communicate any message as to source. *See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). Generic words simply do not, and cannot, perform trademark functions.

Similarly, words that primarily describe something about goods or services do not inherently differentiate as to source. Accordingly, when such words are used in their descriptive sense, they cannot be appropriated by a single competitor. *See Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 543-44 (1920). If, however, a descriptive term has acquired a *second* meaning identifying a single source (*i.e.*, if it has acquired distinctiveness), *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982), the use of that term in its distinctive, trademark sense by a competitor may cause confusion in the marketplace. *See Coca Cola Co. v. Koke Co. of Am.*, 254 U.S. 143, 146 (1920). To permit such *mis*communication would allow a competitor to "poach" on the "commercial magnetism" of another. *See Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).[9]

A different level of protection is accorded for words that are primarily suggestive, arbitrary or fanciful. From the moment of first use, such symbols *can* be protected because consumers inherently react to them as brand signals, and they are *not* necessary for others to communicate in the marketplace. Others freely may rely upon generic and descriptive terms to provide useful information to purchasers, and they may adopt their own unique and inherently distinctive symbols, the number of suggestive, arbitrary, and fanciful terms

[9] Initially, the "Play Doh" brand was at least highly suggestive, if not descriptive, of a dough-like, play product, but it is now a very strong mark that "casts a long shadow which competitors must avoid." *Kenner Parker Toys v. Rose Art Indus.*, 963 F.2d 350, 353-54 (Fed. Cir. 1992).

being limited only by human imagination. *See Stork Restaurant v. Sahati*, 166 F.2d 348, 361 (9th Cir. 1948).

The greater level of protection for inherently distinctive symbols is consistent with one of the principal rationales for trademark protection: "to reduce the cost of information to consumers by making it easy for them to identify the products or producers with which they have had either good experiences, so that they want to keep buying the product ..., or bad experiences, so that they want to avoid the product or the producer in the future." *W.T. Rogers*, 778 F.2d at 338; *see also Qualitex*, 514 U.S. at 163-64. Allowing another in the market place to use the same, or similar, inherently distinctive terms as have been previously adopted would not only increase the likelihood of confusion among potential purchasers, but would also discourage businesses from investing in, and bringing to market, a variety of goods about which they might not be able effectively to communicate.

III. When Trade Dress Performs the Identifying Function of a Word Mark, it is Entitled to Protection Under the Same Principles.

Trade dress has its own spectrum of distinctiveness, albeit one somewhat less developed than that for verbal trademarks. The trade dress categories analogous to those used in word mark cases are described below.

A. There is No Protection for Claimed "Trade Dress" That is Functional.

A product's design is functional "if it is essential to the use or purpose of the article or if it affects [its] cost or quality." *Inwood Labs.*, 456 U.S. at 850 n.10. A functional design is equivalent to a generic word: it cannot be appropriated as trade dress by one competitor because it cannot distinguish goods as originating from one source and is es-

sential to communication and competition.[10] *See generally Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322 (Fed. Cir. 1999); *see also Fun-damental Too, Ltd. v. Gemmy Indus.*, 111 F.3d 993, 1000-01 (2d Cir. 1997).

As Justice Brandeis observed in *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 120 (1938):

> When an article may be manufactured by all, a particular manufacturer can no more assert exclusive rights in a form in which the public has become accustomed to see the article and which, in the minds of the public, is primarily associated with the article rather than a particular producer, than it can in the case of a name with similar connections in the public mind.

Manufacturers often are driven by economic imperatives to produce goods as efficiently as possible, and if a product's design is adapted to its functional purpose, it does little other than to communicate the nature of the product, rather than its origin. As a result, such product designs can rarely be protected. *See, e.g., Textron, Inc. v. United States Int'l Trade Comm'n*, 753 F.2d 1019, 1027 (Fed. Cir. 1985).[11]

B. Even if it is Not Inherently Distinctive, Nonfunctional Trade Dress with Secondary Meaning is Protected.

Like descriptive word marks, some trade dress may be protected only if it has acquired secondary meaning. For example, although not essential to competition in the sense that there is a "need to copy" to compete effectively, *In re*

[10] If a "product is in its particular shape because it works better in this shape," that shape is *de jure* functional. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484 (Fed. Cir. 1984). Heart-shaped boxes thus may not be appropriated by one firm for the sale of Valentine's Day candy.

[11] "No matter how beautifully designed, an industrial product is what it is." *Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595, 601 (S.D.N.Y. 1996).

R.M. Smith, Inc., 734 F.2d 1482, 1484 (Fed. Cir. 1984) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1339 (C.C.P.A. 1982)), trade dress may communicate information about a product by enhancing or reinforcing product attributes or by serving merely to ornament or decorate. In these situations, trade dress is equivalent to a descriptive term, and cannot be protected without a showing of secondary meaning. When, however, a trade dress combination, including elements that have a commonly understood function or a descriptive or ornamental connotation, has acquired secondary meaning, it can serve as an indication of source. Protection against competitive use is required if marketplace confusion is to be avoided. *See Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1218 (8th Cir. 1976).

Imagine, for example, that a manufacturer of reconstituted lemon juice is first to package its product in a yellow, lemon-shaped container. That container clearly describes something (nearly everything) about the nature of the product. If, however, after extensive advertising and promotion, purchasers become conditioned to associate the container, not with its sour contents, but with a particular producer of lemon juice, the manufacturer would be permitted to exclude others from adopting similar containers. *See Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 426 (5th Cir. 1984).

C. There is Immediate Protection for Nonfunctional Trade Dress that is Inherently Distinctive

As this Court properly recognized in *Two Pesos*, trade dress that is "inherently distinctive" may be instantly appropriated by a single competitor, without more, because it is inherently capable of distinguishing goods and it is not necessary that others use it for effective competition or communication.[12] The diversity of packaging trade dress,

[12] The protectability of inherently distinctive trade dress is not impaired because it is incorporated in a utilitarian object: a uniquely designed bot-

again, is limited only by human imagination, and permitting use of similar indicia by competitors would increase the likelihood of confusion. *See Chevron Chem. Co. v. Voluntary Purchasing Groups*, 659 F.2d 695, 703 (5th Cir. 1981).

Trade dress that, *ab initio*, is capable of distinguishing source does not hinder competitors in selling their own goods. For example, if a maker of diapers were to market its goods in packaging that resembled ice cream cones, the uniqueness of the packaging, and the lack of a nexus between it and the product contained in it, would likely engender a brand response from consumers, *see, e.g., In re International Playtex Corp.*, 153 U.S.P.Q. 377, 378 (T.T.A.B. 1967), and there would be no bona fide reason for a competitor to use similar packaging.

IV. *Seabrook* is the Proper Test for Evaluating Inherent Distinctiveness of Product Designs

All but the most basic words, and many packages, may be protected without a showing of secondary meaning because: (i) they generally exist separately from the goods; (ii) they are almost infinitely variable; (iii) their simulation is likely to be motivated by an intent to trade on their good will;[13] and (iv) consumers have been highly sensitized to their brand-differentiating significance. As a consequence, their appropriation as indicators of origin does not pose a threat to the competitive process. *See Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431, 1448 (3d Cir. 1994) ("Product packaging designs, like trademarks, often share membership in a practically inexhaustible set of distinct, but approximately equivalent variations, and an exclusive right to a particular overall presentation generally does not substantially hinder competition in the packaged good, the item in which a consumer has a basic interest."). It is thus accepted wisdom that such symbols should be robustly protected[14] and that the failure to prevent their infringement may diminish both competition and the incentive to invest in product quality and variety.[15]

With product designs, on the other hand: (i) there is less, if any, separation from the goods;[16] (ii) variations are more "finite";[17] (iii) inappropriately extended protection may be harmful to competition;[18] (iv) in many markets, consumers are not accustomed to attach special meaning to designs;[19] and (v) and copying may be motivated by an intent to compete for the good will of the product, not of its producer.[20] As the Restatement explains:

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tle can be protected even though, *de facto*, it holds liquid. *See Ex parte Haig & Haig Ltd.*, 118 U.S.P.Q. 229 (Comm'r Patents 1958).

[13] *See, e.g., Osem Food Indus. v. Sherwood Foods, Inc.*, 917 F.2d 161, 165 (4th Cir. 1990) ("When a newcomer to the market copies a competitor's trade dress, its intent must be to benefit from [plaintiff's] goodwill....").

[14] *See, e.g., Two Pesos*, 505 U.S. at 774.

[15] *See* William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 271-72 (1988).

[16] *See Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 658 (7th Cir. 1995) ("[P]roduct features, though they may identify the source of the product, do not really identify the product—they are the product.").

[17] *Duraco Prods.*, 40 F.3d at 1448.

[18] Costs and commercial considerations with respect to many mass-produced products dictate that they look alike in many respects. *See Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984). Particularly, therefore, if their appearance is viewed as a whole, *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.*, 250 U.S. 28, 29 (1919) ("[I]t is a fallacy to break the fagot stick by stick....") (Holmes, J.), protecting any one feature might chill alternatives or lead to the protection of pedestrian individual elements necessary to effective communication under the theory that they are part of an overall design. *See, e.g., Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 584 (2d Cir. 1993) ("One could no more deny protection to a trade dress for using commonly used elements than one could deny protection to a trademark because it consisted of a combination of commonly used letters of the alphabet.").

[19] *See In re DC Comics, Inc.*, 689 F.2d 1042, 1051 (C.C.P.A. 1982) ("[W]e expect that similar products will come from a number of sources ....") (Nies, J. concurring).

[20] "Sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all—and in the free exercise

> As a practical matter, ... it is less common for consumers to recognize the design of a product or product feature [as opposed to packaging features] as an indication of source. Product designs are more likely to be seen merely as utilitarian or ornamental aspects of the goods. In addition, the competitive interest of copying product designs is more substantial than in the case of packaging.... Product designs are therefore not ordinarily considered inherently distinctive and are thus normally protected only upon proof of secondary meaning.

Restatement, *supra*, § 16 cmt. b; *see also EFS Mktg., Inc. v. Russ Berrie & Co.*, 76 F.3d 487, 491 (2d Cir. 1996) ("[C]onsumers do not associate the design of a product with a particular manufacturer as readily as they do a trademark or product-packaging."); *Sassafras Enters. v. Roshco, Inc.*, 915 F. Supp. 1, 5 (N.D. Ill. 1996) ("[I]t is obviously not impossible for a product's [design] to be inherently distinctive, [but] it is worth mentioning at the outset that [the plaintiff's] burden as to inherent distinctiveness is not an easy one ....").

In view of the differences between packages and products, analytical tools developed for the former may be of little assistance in addressing the design of the latter. Asking, for example, merely whether a product design is "arbitrary" on the *Abercrombie* spectrum may lead to an aberrant result:

> While "arbitrary," "fanciful," or "suggestive" packaging ... may be presumed to serve [a] source-identifying function, and thus may be deemed per se distinctive of the

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of which the consuming public is deeply interested." *Kellogg*, 305 U.S. at 122. Although there is a "general lack of legitimate reasons for copying a competitor's mark," the same may not be true as to its product. *Versa Prods. Co. v. Bifold Co. (Mfg.) Ltd.*, 50 F.3d 189, 201 (3d Cir. 1995).

> source, the same presumption may not be made with regard to product features or designs whose primary purposes are likely to be functional or aesthetic.

Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1008 (2d Cir. 1995) (citation omitted).[21] The floral pattern on hotel china in *Pagliero v. Wallace China Co. Ltd.*, 198 F.2d 339 (9th Cir. 1952), was thus technically "arbitrary," but it was added to enhance salability, not to identify, and it was regarded by hotel buyers as merely decorative. Accordingly, "the *Abercrombie* classifications do not translate easily to the [product] trade dress context ...." *Krueger Int'l*, 915 F. Supp. at 601; *see also id.* ("Does the shape of a chair seat 'suggest' a chair seat? Does it 'describe' a chair seat? Or is it just a chair seat?"). "[T]he very basis for the [*Abercrombie*] trademark taxonomy—the descriptive relationship between the mark and the product, along with the degree to which the mark describes the product—is unsuited for application to the product itself." *Duraco Prods.*, 40 F.3d at 1434.

The ultimate question as to any symbol is whether consumers inherently react to it as a brand or a mere articulation or feature of the goods. With words, there is an array of tools for making such assessments, and because consumers usually react similarly to packages,[22] the same tools may

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[21] The same observation impacts a secondary meaning assessment. For example, while sales are a factor in testing for the secondary meaning of package designs, they may, as to product appearance, reflect only the "desirability of the product configuration rather than the source-designating capacity of the supposedly distinguishing feature." *Duraco Prods.*, 40 F.3d at 1452. There is authority, therefore, that secondary meaning for product appearance can only be established by a consumer survey. *See Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.2d 246 (5th Cir. 1997), *cert. denied*, 118 S. Ct. 1795 (1998).

[22] This is not to say that the *Abercrombie* analysis will always properly balance the interests of the package trade dress claimant and its competitors; reliance on the *Abercrombie* analysis can result, for instance, in the over-protection of packaging trade dress whose principal features are motifs and designs commonly used in the industry.

often be applied. There is, however, no commonly accepted dictionary of product designs, and the test for predicting likely consumer reactions to a product's appearance should thus be stated in visual rather than in verbal terms. INTA submits that the most suitable test that has thus far been formulated appears in *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977), and considers:

> whether the feature [is] a "common" basic shape or design, whether it [is] unique or unusual in a particular field, whether it [is] a mere refinement of a commonly adopted and well-known ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or whether it [is] capable of creating a commercial impression distinct from the accompanying words.[23]

The uniqueness of a product's design should be assessed in relationship to the product itself,[24] as well as with respect to other goods in the market, and the *Seabrook* formulation

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[23] To the extent that a consensus exists on the proper test for inherent distinctiveness, the *Seabrook* framework has already met with widespread acceptance in the product appearance context and constitutes the apparent majority rule. *See, e.g., I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 33 (1st Cir. 1998); *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 857-58 (11th Cir. 1983); *see also Swisher Mower & Mach. Co. v. Haban Mfg., Inc.*, 931 F. Supp. 645, 649-50 (W.D. Mo. 1996); *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 603 (S.D.N.Y. 1996); *Ergotron, Inc. v. Hergo Ergonomic Support Sys., Inc.*, No. 94 CIV 2732, 1996 U.S. Dist. LEXIS 3822, at *14-15 (S.D.N.Y. March 29, 1996); *National Presto Indus. v. Hamilton Beach, Inc.*, 18 U.S.P.Q.2d 1993, 1999 (N.D. Ill. 1990); *Bloomfield Indus. v. Stewart Sandwiches, Inc.*, 716 F. Supp. 380, 385 (N.D. Ind. 1989). Indeed, even courts that have continued to apply *Abercrombie* to product appearance have recognized the value of reliance on *Seabrook* as well. *See, e.g., Ashley Furniture Indus. v. Sangiacomo N.A.*, 187 F.3d 363, 370-71 (4th Cir. 1999).

[24] *Chevron Chem. Co.*, 659 F.2d at 702 (a feature cannot "function either to describe the product or assist in its effective packaging").

should be applied as part of a multi-level, fact and market sensitive inquiry that takes into account:

> 1. *Consumer Perception in the Relevant Market*: Any determination of trade dress distinctiveness properly should consider whether, in a particular market segment, consumers are likely to regard a product's appearance as source significant or merely as a temporal effort to make goods more attractive to buyers. For example, consumers often distinguish between the products offered by competing manufacturers of automobiles and golf clubs based on the design features of those respective products. *See, e.g., Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts*, 944 F.2d 1235, 1246 (6th Cir. 1991) ("Ferraris need no labeling; the shape of the vehicles 'says Ferrari.'"); *see also Liquid Glass Enters. v. Porsche AG*, 8 F. Supp. 2d 398 (D.N.J. 1998); *Callaway Golf Co. v. Golf Clean, Inc.*, 915 F. Supp. 1206 (M.D. Fla. 1995). In contrast, however, consumers may regard the design of an inexpensive Grecian-style plastic planter as engendered by cost and salability considerations. *See, e.g., Duraco Prods.*, 40 F.3d at 1452.
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> 2. *The Degree of Uniqueness*: Because consumers are not as ready to regard product appearance as source indicative, a court should not stop the analysis upon finding that a feature of a design is "unique or unusual," *see Seabrook*, 568 F.2d at 1344-1345, but should continue to assess the degree to which a design incorporating unique or unusual elements is striking and memorable or is predominantly ornamental. Courts should consider "whether the design, shape or combination of the elements is so unique, unusual or unexpected in [the] market that one can assume without proof that it will automatically be perceived by customers as an indici[um] of origin." *Krueger*, 915 F. Supp. at 603 (emphasis omitted)

(quoting 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8.02[4], at 8-23 (1996 ed.)). If unique elements or unique combinations of commonplace elements immediately set a claimant's design apart, such circumstances ordinarily would weigh in favor of a finding of inherent distinctiveness. *See, e.g., Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1174 (N.D.N.Y. 1995). If, however, the claimed elements or combination of elements are widely used in the industry, such use properly should make a showing of inherent distinctiveness virtually impossible. *See, e.g., EFS Mktg., Inc. v. Russ Berrie & Co.*, 76 F.3d 487, 491 (2d Cir. 1996); *Judith Ripka Designs, Ltd. v. Preville*, 935 F. Supp. 237, 257 (S.D.N.Y. 1997).

3. *The Intent Underlying the Claimed Design*: Absent any intent *a priori*, after-the-fact assertions by trade dress claimants that their product's appearance is inherently distinctive have fared poorly in the courts. *See Duraco Prods.*, 40 F.3d at 1450; *see also Meadowcraft, Inc. v. B.I. Indus.*, 226 U.S.P.Q. 244, 247 (N.D. Ala. 1985); *Major Pool Equip. Co. v. Ideal Pool Corp.*, 203 U.S.P.Q. 577, 583-84 (N.D. Ga. 1979). If a claimant did not itself evidence an intent that a product's design would function as an indicator of origin, it is unlikely that consumers would make the leap. *See, e.g., Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1071 n.5 (S.D.N.Y. 1995); *In re Kwik Lok Corp.*, 217 U.S.P.Q. 1245, 1248 (T.T.A.B. 1983). Thus, courts properly should consider whether there is an intent to differentiate, as reflected in advertising or otherwise.[25]

[25] As noted in *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 662 (7th Cir. 1995):

> Advertising that touts a product feature for its desirable qualities and not primarily as a way to distinguish the producer's brand is not only not evidence

These considerations, however, are neither mutually exclusive nor individually determinative, and in primarily addressing Samara's intent, the Court of Appeals may have lost focus on the ultimate inquiry. "[R]egardless of the [trade dress owner's] intentions, it is the association, by the *consumer*, of the ... design with [the trade dress owner] as the source that is determinative." *Seabrook*, 568 F.2d at 1345; *see also Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 827 (C.C.P.A. 1975) ("[I]t is the association of the [trade dress] with a particular source by the ultimate consumers which is to be measured—not [the claimant's] intent."). Because of the ease with which testimony of intent may be procured, a finding of inherent distinctiveness should not rest merely on statements by a claimant that it meant to differentiate its product from those of competitors.[26] Indeed, because design differentiation may be for the purpose of making goods more salable, an intent to differentiate can never be alone dispositive.

Moreover, a balance must be preserved between competition and product design appropriation. On the one hand, many goods are purchased because of their design *and* be-

> that the feature [is inherently distinctive or] has acquired secondary meaning, it directly undermines such a finding. It supports instead the inference that consumers consider the claimed trade dress a desirable feature of the product and not primarily a signifier of source.

[26] The question is always whether "customers demand [goods] made by the plaintiff rather than merely [goods] of the type plaintiff makes." *Atlantis Silverworks, Inc. v. 7th Sense, Inc.*, 42 U.S.P.Q.2d 1904, 1908-09 (S.D.N.Y. 1997). Intent may thus function as a shield, to blunt attacks that an appearance is inherently common, but it should not function as a sword, as proof, in and of itself, that an appearance is distinctive. As stated in a "likelihood of confusion" context, but with equal relevance to the protection of product appearance, the First Circuit in *Chrysler v. Silva* observed that "intent, or lack thereof, does not affect the eyes of the viewer. Proof of bad intent may, psychologically, hurt as an admission. Proof of good intent does not change appearance." 118 F.3d at 59 n.3 (citation omitted).

cause they come from a particular source, *e.g.*, "for the purpose of acquiring the prestige gained by displaying what many visitors at the customer's homes [or businesses] would regard as a prestigious article." *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-LeCoultre Watches, Inc.* 221 F.2d 464, 466 (2d Cir. 1955). Consumers therefore may not purchase many products in design-sensitive markets unless the exclusivity of a design's association with its producer can be preserved,[27] and firms may not invest in creating designs that are both pleasing and identifying if others may freely copy.[28] Accordingly, competition may be limited if distinctive, source-identifying, product appearances are not afforded trade dress protection or are required, as in *Landscape Forms*, 113 F.3d at 381-82, to be delineated with the precision of patent claims.[29]

On the other hand, as appropriately noted in *Landscape Forms*, 113 F.3d at 380, "granting trade dress protection to an ordinary product design [may] create a monopoly in the goods themselves." Care clearly must be exercised to preserve competitive access to "common basic shape[s]" and "well-known [forms of] ornamentation." *See Seabrook*, 568 F.2d at 1344. There typically are many devices that firms can use to denote origin,[30] and the standard for inherent distinctiveness in product designs should be sufficiently high to preclude impairment of "competitive interests." For the most part, to iterate, protection should be limited to those designs and design combinations that are "so unique, unusual or unexpected" that "one can assume without proof that [they] will automatically be perceived" as source signals. *See Krueger*, 915 F. Supp. at 603.

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[27] David M. Tichane, *The Maturing Doctrine of Post-Sale Confusion*, 85 TRADEMARK REP. 399, 400 (1995).

[28] *See* Landes & Posner, *supra*, 78 TRADEMARK REP. at 271-72.

[29] *See* Dinwoodie, *supra*, 75 N.C.L. REV. at 474 n.8 (observing that "alternative forms of intellectual property protection [have] ... failed to offer adequate protection to product design").

[30] *See, e.g., Versa Prods.*, 50 F.3d at 201.

To illustrate the foregoing, it is submitted that the design of a Rolex watch is inherently distinctive: (i) the design is unique; (ii) the design is capable, apart from the name on the face, of creating a distinct commercial impression; (iii) many consumers are accustomed to differentiating watch sources by their appearance; (iv) the design is memorable; (v) unusual watch designs are normally created to identify source; and (vi) there are both common basic shapes and other source-denoting designs available to competitors.[31] The principal nexus between commerce and appearance is reputational, and the failure to protect such designs would impair competition and confuse consumers.

With respect to wrought iron furniture sold by mass merchants, on the other hand, typically: (i) it incorporates, at best, mere refinements of commonly adopted and well-known ornamentation for that class of goods; (ii) its source is denoted by word marks, not appearance; (iii) consumers at the mass market level are looking for something like their neighbors have, not for a cutting-edge design; (iv) consumers cannot recall design differences even traveling from store to store; (v) appearance is driven by the need to sell four chairs and a table for less than $100; and (vi) only a traditional look will sell in sufficient volume to warrant space on a mass merchant's floor.[32] The principal nexus between commerce and appearance are cost and salability, and the protection of such designs would thus result in a limited monopoly.

Few product design cases can be resolved with the ease suggested by the proffered examples, but INTA submits that focusing on visual uniqueness and memorability, in the context of particular markets, while assuring that salable alternatives are available, will best promote consumer protection and efficient competition.

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[31] *See Rolex Watch U.S.A., Inc. v. Thalmeimer Co.*, 217 U.S.P.Q. 964 (N.D. Cal. 1982).

[32] *See Meadowcraft Inc. v. Compex Int'l Co.*, 47 U.S.P.Q.2d 1665 (N.D. Ga. 1998).

CONCLUSION

Assessments of inherent distinctiveness involve predictions as to consumer reactions. In deciding how consumers are likely to react to words and packages, verbal guidelines have generally proven to be useful. In deciding how consumers are likely to react to product designs, INTA submits that visual guidelines, tempered by the market, are more helpful.

In each instance, the touchstone of protection is the communication and appreciation of a distinguishing, source-identifying message. Merely applying to product appearance the same rules that are applied to words and packaging would distort how consumers in many markets typically perceive the two, and may impair competition in products generally. An excessive concern for competition, on the other hand, by overly precluding the appropriation of designs, can actually impair efficiency, undermine symbols on which consumers rely, and limit consumers' access to products of quality and variety.

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